

### REMARKS

This Amendment is in response to the Office Action mailed January 11, 2006.

**I. IDS submitted with the application is proper and should be considered**

Applicant submits herewith copies of the *Information Disclosure Statement* and modified form PTO-1449 as filed with the original application in full compliance with 37 C.F.R. §1.98(a)(1), and the *PTO stamped return postcard* acknowledging receipt of same. It should be noted that the IDS and the modified form PTO-1449 are separate papers.

**II. 35 U.S.C. §112(2) Rejections**

Claims 7, 10, and 20, have been amended to address the §112(2) rejections.

**III. 35 U.S.C. §102(e) Rejections**

Claims 1-3, 10-16, 24 and 37, are rejected under 35 U.S.C. §102(e) as being anticipated by D'Luna et al. (20020106018). Reconsideration and withdrawal of these rejections are respectfully requested.

D'Luna does not teach:

an input, the input being configured to accept a plurality of input streams;

an output, the output being configured to selectively output a plurality of output streams;

a first digital bus connected coupled between the input and output, the first digital bus being uninterrupted between the input and the output such that a digital signal at presented at the input of is carried unchanged over the first digital bus to the output;

As shown in Fig. 1 and as claimed in independent claim 1, the first digital bus 128 is uninterrupted between the input and the output. As the Examiner can see from inspection of Fig. 1, the first digital bus 128 is indeed uninterrupted between the multiplexer 126 of the claimed input and the multiplexer 168 of the claimed output. As shown in Fig. 1 of the present

application, any digital signal presented at the input side of the digital bus 128 will be carried unchanged to the output side thereof. The same cannot be said of any digital bus in D'Luna. The Office appears to acknowledge as much, citing elements 124 to 104 to 111/106 as corresponding to the claimed first digital bus. The presence of the Tuner Power Amp 124, the transceiver 104, the transport processor 111 and the AV decoder 106 precludes any interpretation of the system on a chip 100 corresponding to the claimed interactive TV device that includes a digital bus that is uninterrupted between the input and output. Specifically, digital signals presented to the path defined by the Examiner in D'Luna's system on a chip will at least be processed (in transport processor 111) and decoded (in AV decoder 106). D'Luna does not teach any "first digital bus coupled between the input and output, the first digital bus being uninterrupted between the input and the output such that a digital signal at presented at the input of is carried unchanged over the first digital bus to the output", as claimed in amended claim 1. Reconsideration and withdrawal of the §102(e) rejections applied to claim 1 and its dependent claims are, therefore, respectfully requested.

#### IV. 35 U.S.C. §103(a) Rejections

**The Examiner's reliance upon inherency is misplaced, in error and does not conform with the USPTO's own standards concerning inherency.**

The MPEP sets forth strict guidelines for the use of Official Notice, which the Office has not adhered to in the present case. In support of the rejection of claims 4, 5, 6, 7, 8, 9, 23, 27, 28, 33 and 34, the Office has relied upon the use of Official Notice. The applicant traverses such Official Notices on the following grounds.

**A. Sole grounds for rejection**

It is noted that the sole ground for rejecting each of these dependent claims is the Official Notice. The Office, however, is respectfully reminded of the unambiguous guidance provided by the PTO's own MPEP in §2144.03:

Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421. (Emphasis Added).

Official Notice was not used in claims 4, 5, 6, 7, 8, 9, 23, 27, 28, 33 and 34 to "fill in the gaps" in an "insubstantial manner". Instead, Official Notice is the sole grounds for rejecting each of the claims. In each case, the Examiner acknowledges that the claimed structure or feature is not taught in the applied reference and relies upon an injudicious use of Official Notice that the missing structure or feature was "notoriously well known." Here, the Office has relied solely on common knowledge in the art without evidentiary support in the record as the principal and only evidence upon which the rejections are based, which is clearly forbidden both by the *Ahlert* and *Zurko* courts and the Patent Office's own MPEP.

**B. When Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line Of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable**

It is respectfully submitted that a) the Office has applied Official Notice to assert that the claimed structures or features are "notoriously well know" and has not supported such assertions by documentary evidence, and b) has not provided any technical line of reasoning or c) has not provided a technical line of reasoning that is clear and unmistakable.

Indeed, the Office did not present any line of reasoning (technical, clear, unmistakable or otherwise) for asserting Official Notice in claims 5, 6, 7, 8, 9, 27, 28, 33 and 34. In each case, the Examiner only states that "it is notoriously well known" to \_\_\_\_\_ (provide the feature of the claim), without providing any line of reasoning whatsoever. Thereafter, the Examiner asserts that it would have been obvious to modify the primary reference to incorporate the structure for which Official Notice was taken. There is no clear and unmistakable line of reasoning presented in the rejection of these claims.

For example, in support of the Official Notice of the Digital Video Bus of claim 4, the Examiner does provide a line of reasoning, which reads as follows: "Accordingly, it would have been obvious to one of ordinary skill in the art to modify D'Luna in order to enjoy the benefits of DVB because of its tight integration with the Internet Protocol through IP Encapsulation." Neither the applicants nor the undersigned understands what "IP Encapsulation" is, or how "IP Encapsulation" is the means by which tight integration with some undefined Internet Protocol may be achieved, nor has the Office provided any explanations as to what that sentence means. It is respectfully submitted that this does not constitute the required "clear and unmistakable technical line of reasoning" required by the courts or the Office's own standards as set forth in the MPEP.

Similarly, the line of reasoning provided in support of the use of Official Notice in claim 27 is "it is notoriously well known in the art to utilize a localized EPG wherein the user may enter his zip code...." In claim 28, the asserted line of reasoning is that it would have been obvious to "customize an EPG." Neither the applicants nor the applicants' representatives know what a "localized EPG" is or how to customize one, nor has the Office provided any explanations. This is not the required "technical line of reasoning" nor is it by any means "clear

and unmistakable." Again, it is respectfully submitted that the Office has not applied Official Notice properly.

Similar defects exist in each of the Office's applications of Official Notice. It is respectfully submitted therefore, that the Office's use of Official Notice is fatally defective and that the rejections based solely upon such defective Official Notices should be reconsidered and withdrawn.

Claims 56-46 are canceled.

As amended claim 1 has been distinguished from D'Luna and the anticipation rejection overcome, it is respectfully submitted that this application is in condition for allowance. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below and whatever is necessary to resolve such issues will be done at once.

Respectfully submitted,

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